



DAC/8#11

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Group Art Unit: Unknown

UWE WITT ET AL.

Examiner: Unknown

Serial No.: 08/793,966

Filed: March 10, 1997

For: BIOLOGICALLY DEGRADABLE POLYESTER AND  
WORKING MATERIAL CONSISTING THEREOF

Attorney Docket No.: BOET 0103 PUSA

RECEIVED  
AUG 25 2000  
OFFICE OF PETITIONS

**PETITION TO REVIVE AN APPLICATION FROM  
UNINTENTIONAL ABANDONMENT UNDER 37 C.F.R. 1.137(B)**

RECEIVED  
18 JUN 2002  
Legal Staff  
International Division

Box DAC  
Assistant Commissioner for Patents  
Washington, D.C. 20231

Sir:

On April 1, 1999, Applicants filed a Petition to revive the above-identified application for unavoidable abandonment. Enclosed is a copy of Applicants' Petition and showing (Exhibit A) which adequately sets forth the facts, including the fact that the Office failed to appraise Applicants of the abandonment of the application. By Decision dated February 3, 2000 (Exhibit B), Applicants' attorney was informed that the Petition was not granted, but that Applicants could petition for revival for unintentional abandonment under 37 C.F.R. 1.137(b).

On March 2, 2000, a letter (Exhibit C) was directed to the clients' German patent agent asking whether the petition for unavoidable abandonment (37 C.F.R. § 1.137(a)

08/22/2000 EXAMFOND 00000099 08793966

01 FC:141

1210.00 OP

**CERTIFICATE OF MAILING UNDER 37 C.F.R. § 1.8**

I hereby certify that this paper, including all enclosures referred to herein, is being deposited with the United States Postal Service as first-class mail, postage pre-paid, in an envelope addressed to: Box DAC, Assistant Commissioner for Patents, Washington, D.C. 20231 on:

August 14, 2000  
Date of Deposit

William G. Conger  
Name of Person Signing

Signature

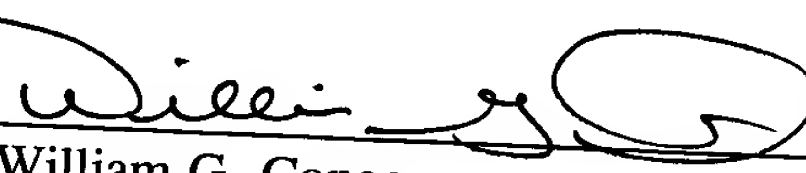
should be converted to one of unintentional abandonment under 37 C.F.R. § 1.137(b). When no response was forthcoming, a reminder was telefaxed on June 21, 2000. A reply telefax on July 28, 2000 indicated that the original telefax had never been received by the foreign agent, but that per the client's wishes, a Petition for Unintentional Abandonment should be filed (Exhibit D).

Therefore, please consider the attached copy (Exhibit A) of the petition under 37 C.F.R. § 1.137(a) to a petition for unintentional abandonment under 37 C.F.R. § 1.137(b). The entire delay between Applicants' first knowledge of the abandonment of the application and the date of the present Petition was unintentional. No terminal disclaimer is necessary since the application was filed after June 8, 1995. A check in the amount of \$1,210.00 for the Petition fee (37 C.F.R. § 1.17(m)) is enclosed. Although the Declaration executed by all three inventors was previously filed, a true copy is filed herewith (Exhibit E) as an exercise of extreme caution.

Please charge any additional fees or credit any overpayments as a result of the filing of this paper to our Deposit Account No. 02-3978 -- a duplicate of this paper is enclosed for that purpose.

Respectfully submitted,

UWE WITT ET AL.

By   
William G. Conger  
Reg. No. 31,209  
Attorney for Applicant

Date: August 14, 2000

**BROOKS & KUSHMAN P.C.**  
1000 Town Center, 22nd Floor  
Southfield, MI 48075  
Phone: 248-358-4400  
Fax: 248-358-3351

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

UWE WITT ET AL.

Group Art Unit:

Serial No.: 08/793,966

Examiner:

Filed: March 10, 1997

For: BIOLOGICALLY DEGRADABLE POLYESTER AND  
WORKING MATERIAL CONSISTING THEREOF

RECEIVED

AUG 25 2000

OFFICE OF PETITIONS

Attorney Docket No.: BOET 0103 PUSA

**COMBINED PETITION FOR REVIVAL OF AN APPLICATION  
FOR PATENT ABANDONED UNAVOIDABLY UNDER 37 C.F.R. 1.137(a)  
AND SHOWING RELATED THERETO UNDER 37 C.F.R. 1.137(a)(3)**

Box DAC  
Assistant Commissioner for Patents  
Washington, D.C. 20231

Sir:

Applicants hereby petition for revival of the above-identified application which was unavoidably abandoned. The Petition fee (37 C.F.R. § 1.17(l)) accompanies this Petition. Applicants showing is set forth below. Applicants have submitted this Petition under 37 C.F.R. § 1.137(a), but believe that it could have been presented as a request for reinstatement of an application erroneously abandoned by the Office. The facts are set forth below.

1. On September 14, 1998, Applicants requested to be informed of the status of US Patent application serial number PCT/EP95/02722. On November 19, 1998, Applicants received a letter from the PCT legal office indicating that this application had been abandoned, and that a NOTIFICATION OF ABANDONMENT had been mailed on January 2, 1998.

**CERTIFICATE OF MAILING UNDER 37 C.F.R. § 1.8**

I hereby certify that this paper, including all enclosures referred to herein, is being deposited with the United States Postal Service as first-class mail, postage pre-paid, in an envelope addressed to: Box DAC, Assistant Commissioner for Patents, Washington, D.C. 20231 on:

April 1, 1999  
Date of Deposit

William G. Conger  
Name of Person Signing

Signature

2. This application was filed with a defective Declaration which did not properly identify the citizenship of the inventors. The Declaration was however signed by all inventors. A notice to file missing parts was issued on April 16, 1997, giving a one month period to reply, extendable under 37 C.F.R. § 1.136(a) for a period of up to five months. On 15 May, 1997, within the one month period, Applicants submitted the Declaration signed by two of the three inventors. The third inventor had meanwhile left the employ~~ee~~ of the assignee. This second Declaration properly indicated the citizenship of all of the inventors. On June 25, 1997, a notification of a defective response was submitted by the PCT legal office. This notification of defective response indicated that applicant is required to complete the response within a time of one month or five months from the date of response set in the Notification of Missing Requirements. This latter date would have been October 16, 1997.

3. Applicants' attorney believed that the two Declarations together fully satisfied the requirements of 37 C.F.R. § 1.497 and 37 C.F.R. § 1.63, and filed a response directing the office's attention to M.P.E.P. § 602.02 which indicated that:

Where neither the original oath or declaration, nor the substitute oath or declaration is complete in itself, but the two taken together give all the required data, no further oath or declaration is needed.

The two Declarations together did indeed give all the required data. Applicants submitted this response to the Patent and Trademark office on July 8, 1997, again well within the one month period of response required by the Notification of a Defective Response, and also within the five month period from the initial notice, which period would expire on October 16, 1997. Applicants received no further communication from the office until they received a letter dated 17 November, 1998 in response to Applicants' Request for Status of the Application, indicating that the application had been abandoned.

4. Applicants' attorney telephoned the PCT legal office and requested a copy of the Notice of Abandonment, which had never been received. Subsequently, a copy of a Notice of Abandonment was received which, however, failed to identify the application. Notably, the serial number was wrong, the first named Applicant was wrong, and the address

in Florina, Greece was totally wrong. Applicants are unfamiliar with any of the individuals, with the serial number, or the address identified in this Notification of Abandonment. Applicants never received the Abandonment.

5. Applicants believed that their response filed on July 8, 1997 was a satisfactory response in every respect to the Notification of Defective Response mailed June 25, 1997 and if not totally satisfactory, was at least a bona fide effort to respond. At the very least, Applicants believe that the Office has a duty to inform Applicants when a response is not sufficient.

6. The Manual of Patent Examining Procedure, in Section 714.05, states:

Actions by applicant, especially those filed near the end of the period for response, should be inspected immediately upon filing to determine whether they are completely responsive to the preceding Office action so as to prevent abandonment of the application. If found inadequate, and sufficient time remains, application should be notified of the deficiencies and warned to complete the response within the period.

The Patent Statutes, 35 U.S.C. § 132, indicates that "whenever, on Examination, a claim for a patent is rejected, or any objection or requirement made, the Commissioner shall notify the applicant thereof . . . ."

7. Applicants believed that their response was completely adequate to resolve the issue of the defective Declaration. If not, Applicants would have expected to receive further notification that their response was insufficient. In keeping with M.P.E.P. § 714.05, sufficient time still remained for Applicants to reply if their response were held insufficient. Factually, more than 3 months of the entered period remained. However, Applicants could not be aware that their response was insufficient without being notified of any alleged insufficiency. This, the office never did. Moreover, the Office never informed Applicants of the abandonment of their application. Applicants never received any indication that their prior response was defective and that therefore the period for response was continuing to run. Had the office indicated that the July 8, 1997 response of Applicants was

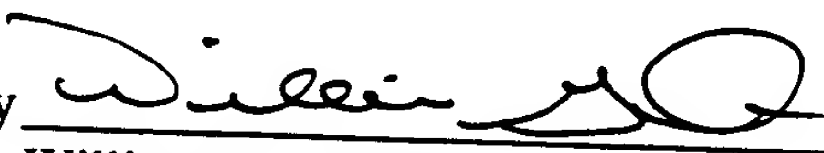
defective in any way, Applicants would have still had time to respond by submitting an Extension of Time extending the time period well into October. Because Applicants never received any notification that this time period was running, and because Applicants never received any indication that the case was abandoned, Applicants submit that the abandonment was unavoidable.

While Applicants believe that their prior response and the two Declarations previously submitted both a bonafide attempt to respond as well as a sufficient response under the law, submitted herewith is a Declaration signed by all three inventors which without question meets all of the statutory requirements.

A check in the amount of \$55.00 is enclosed to cover the Petition fee. Please charge any additional fees or credit any overpayments as a result of the filing of this paper to our Deposit Account No. 02-3978 -- a duplicate of this paper is enclosed for that purpose.

Respectfully submitted,

UWE WITT ET AL.

By 

William G. Conger

Reg. No. 31,209

Attorney for Applicant

Date: April 1, 1999

**BROOKS & KUSHMAN P.C.**  
1000 Town Center, 22nd Floor  
Southfield, MI 48075  
Phone: 248-358-4400  
Fax: 248-358-3351





UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
BOX PCT  
Washington, D.C. 20231

08/732,272 VAGOURDIS

|                    |                       |                  |
|--------------------|-----------------------|------------------|
| US APPLICATION NO. | FIRST NAMED APPLICANT | ATP NO. 00000000 |
|--------------------|-----------------------|------------------|

DIMITRIOS VAGOURDIS  
121 PAVOYMELAI. GR-531.00  
FLORINA  
GREECE

5621

D  
INTERNATIONAL APPLICATION NO. 000006

PCT/GR96/000006

|                  |               |
|------------------|---------------|
| I.A. FILING DATE | PRIORITY DATE |
|------------------|---------------|

03/01/96

03/01/95

DATE MAILED: 01/02/98

### NOTIFICATION OF ABANDONMENT

The United States Patent and Trademark Office in its capacity as  
☐ a Designated Office (37 CFR 1.494), ☒ an Elected Office (37 CFR 1.495), has made the following determination:

- ☐ Applicant's letter of express abandonment received \_\_\_\_\_ is in compliance with 37 CFR 1.138 and is hereby acknowledged.
- ☐ Applicant has failed to provide the full U. S. Basic National Fee by ☐ 20 months (37 CFR 1.494 (b)(2)), ☐ 30 months (37 CFR 1.495 (b)(2)).
- ☐ Applicant has failed to respond to the notification of MISSING REQUIREMENTS (Form PCT/DO/EO/905), mailed \_\_\_\_\_ within the time period set therein.
- ☐ Applicant has failed to properly respond to the notification of MISSING REQUIREMENTS (Form PCT/DO/EO/905), mailed \_\_\_\_\_ within the time period set therein. See the attached NOTIFICATION OF A DEFECTIVE RESPONSE (Form PCT/DO/EO/916).
- ☒ Other: *Applicant has failed to properly respond to the Defective Response Notice. 1st Declaration citizenship was omitted and Declaration one Applicant did not sign.*

Therefore, the above identified application failed to meet the requirements of 35 U.S.C. 371 and 37 CFR ☐ 1.494, ☒ 1.495 and is ABANDONED AS TO THE UNITED STATES OF AMERICA.

*Anita Johnson*

Telephone: (703) 305-3661

Anita Johnson  
PCT International Division





17 NOV 1998



UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office

Box 3103 PUSA

Patent Cooperation Treaty  
Legal Office

Address: Assistant Commissioner for Patents  
Box PCT  
Washington, D.C. 20231



William G. Conger  
1000 Town Center  
Twenty-Second Floor  
Southfield, Michigan 48075

Dear Mr. Conger,

This is in response to your letter received 17 September 1998 inquiring about the status of the U.S. national stage filing of PCT/EP95/02722 which has been assigned U.S. application number 08/793,966. Accordingly to U.S. Patent and Trademark Office records, the United States Designated/Elected Office (DO/EO/US) mailed applicant a NOTIFICATION OF ABANDONMENT(FORM PCT/DO/EO/909) on 02 January 1998 and application number 08/793,966 is now abandoned. A copy of the 02 January 1998 NOTIFICATION is attached to this communication.

Sally Gardner-Lane  
PCT Detailee  
PCT Legal Office

Jennifer D. Bahr  
PCT Legal Examiner  
PCT Legal Office

SGL/JDB:sgl

Tel: (703)305-5474  
Fax: (703)308-6459

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In regard to International Application

Group Art Unit: Unknown

UWE WITT ET AL.

Examiner: Unknown

Serial No. PCT/EP95/02722

Filed: 12 July 1995

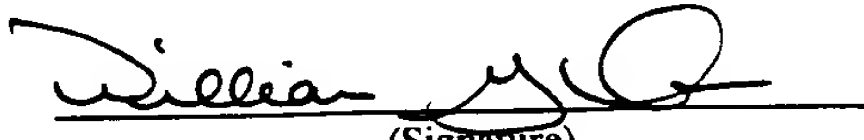
Title: BIOLOGICALLY DEGRADABLE POLYESTER AND  
WORKING MATERIAL CONSISTING THEREOF

Attorney Docket No.: BOET 0103 PUSA

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231 on

September 14, 1998  
(Date of Deposit)

William G. Conger  
Reg. No. 31,209

  
(Signature)

**STATUS LETTER**

Assistant Commissioner for Patents  
Washington, D.C. 20231

Sir:

Upon reviewing the above identified patent application, we note that we have received no further correspondence on this file since Applicants' Response To "Notification Of a Defective Response" dated July 7, 1997 was mailed to the Patent and Trademark Office. Please advise us of the status of this patent application.

Respectfully submitted,

UWE WITT ET AL.

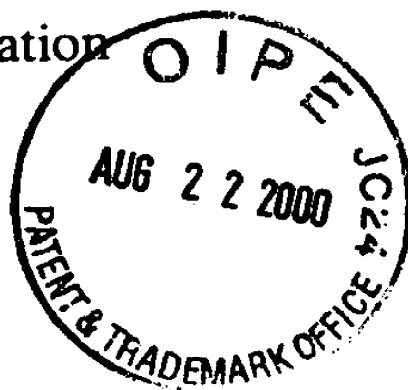
BROOKS & KUSHMAN P.C.



William G. Conger  
Registration No. 31,209  
Attorney of Record  
1000 Town Center  
Twenty-Second Floor  
Southfield, Michigan 48075  
(810) 358-4400

WGC/slk

Dated: September 14, 1998



RECEIVED  
AUG 25 2000  
OFFICE OF PETITIONS

UNDER THE PATENT COOPERATION TREATY  
BEFORE THE UNITED STATES RECEIVING OFFICE

In regard to International Application:

Serial No.: PCT/EP95/0272

Applicant: UWE WITT et al.

Filed: 12 July 1995

Authorized Officer:  
Anita Johnson

U.S. Application No. 08/793,966

Title: BIOLOGICALLY DEGRADABLE POLYESTER AND  
WORKING MATERIAL CONSISTING THEREOF

I hereby certify that this correspondence is being deposited with  
the United States Postal Service via Express Mail Label No.  
EF751219695US in an envelope addressed to: Assistant  
Commissioner for Patents, BOX PCT, Washington, D.C. 10131 or

7/8/97  
(Date of Deposit)

Joan Farragher

(Signature)

**APPLICANTS' RESPONSE TO "NOTIFICATION OF A DEFECTIVE RESPONSE"**

On March 10, 1997, Applicants entered the National Phase in the United States in the above-identified PCT application. Submitted along with the remaining formal papers was a Declaration by the three named inventors. The Office mailed a "Notification of Missing Requirements..." (PTO Form PCT/DO/EO/905) dated April 16, 1997, indicating that the Declaration was defective for failing to identify the citizenship of each inventor. The citizenships of the second and third inventors had inadvertently been omitted. The Declaration met all other legal requirements.

On May 15, 1997, Applicants submitted a Supplemental Declaration which identified the citizenship of the second and third inventors, and which was executed by the second and third inventors. The Supplemental Declaration was not executed by the first inventor. However, the citizenship of the first inventor

had been correctly identified in the original Declaration which, in turn, had been executed by the first inventor. Applicants subsequently received a "Notification of a Defective Response" (Form PCT/DO/EO/916) dated June 25, 1997.


It is respectfully submitted. that the two Declaration together fully satisfy the requirements of 37 C.F.R. § 1.497 and 37 C.F.R. § 1.63. Copies of both Declarations and the "Notification of a Defective Response" are enclosed herewith. In this respect, attention is directed to MPEP § 602.02:

Where neither the original oath or declaration, nor the substitute oath or declaration is complete in itself, but the two taken together give all the required data, no further oath or declaration is needed.

Thus, Applicants believe that the requirements of 37 C.F.R. § 1.497 have been fully complied with, and Applicants respectfully request acknowledgement that the two declarations submitted indeed fulfill the requirements.

Respectfully submitted,

Uwe Witt et al.  
BROOKS & KUSHMAN P.C.

  
William G. Conger  
Registration No. 31,209  
Attorney of Record  
1000 Town Center, 22nd Floor  
Southfield, Michigan 48075  
(248) 358-4400

Dated: July 8, 1997  
WGC:jbf  
Enclosures

08/793.966

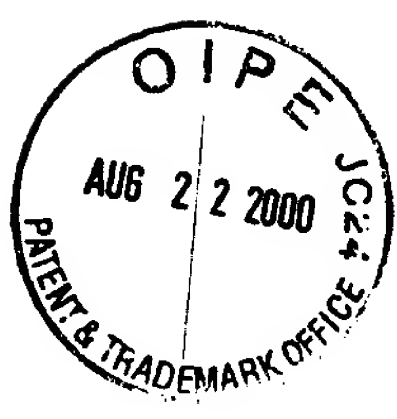
U.S. APPLICATION NO. 08/793.966

UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office  
Address: ASSISTANT COMMISSIONER FOR PATENTS  
Box PCT  
Washington, D.C. 20231

FIRST NAMED APPLICANT WITT

ATTY. DOCKET NO. 0

BOET 0103 PU



MR. WILLIAM G. CONGER  
BROOKS & KUSHMAN PC  
1000 TOWN CENTER  
TWENTY-SECOND FLOOR  
SOUTHFIELD MI 48075

INTERNATIONAL APPLICATION NO. 5611

PCT/EP95/02722

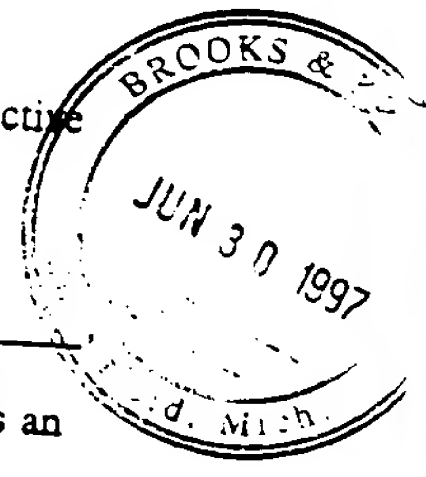
I.A. FILING DATE 07/12/95

PRIORITY DATE 09/09/94

DATE MAILED: 06/25/97

NOTIFICATION OF A DEFECTIVE RESPONSE

- ☐ The request for an extension of time (37 CFR 1.136(a)) filed \_\_\_\_\_ is defective because the required fee is missing/insufficient. Extension of time fees are listed at 37 CFR 1.17(a)-(d).
- ☐ Applicant's response filed \_\_\_\_\_ was received in the Office on \_\_\_\_\_ which is after the expiration of the period for response set in the last Office notification mailed \_\_\_\_\_. This application will become abandoned unless applicant obtains an extension of time to reply to the last Office notification under 37 CFR 1.136(a).
- ☒ Applicant's response filed 15 MAY 97 included the following items, the receipt of which is hereby acknowledged:



Due: 7-25-97  
Out: 7-11-97

- ☐ Copy of the international application in:
  - ☐ a non-English language.
  - ☐ English.
- ☐ Translation of the international application into English ☐ which is defective for the reasons indicated on the attached Notice of Defective Translation.
- ☐ Processing fee (37 CFR 1.492(f)) ☐ which is insufficient.
- ☒ Oath or Declaration of inventor(s).
  - ☐ in compliance with 37 CFR 1.497(a) and (b).
  - ☐ not in compliance with 37 CFR 1.497(a) and (b) for the reasons indicated on the attached PCT/DO/EO/917.
- ☒ Surcharge (37 CFR 1.492(e)) ☐ which is insufficient.
- ☐ Copy of Article 19 amendments.
- ☐ Translation of Article 19 amendments into English.
- ☐ The International Preliminary Examination Report in English and its Annexes, if any.
- ☐ Translation of Annexes to the International Preliminary Examination Report into English.
- ☐ Preliminary amendment(s).
- ☐ Information Disclosure Statement(s).
- ☐ Assignment document.
- ☐ Power of Attorney and/or Change of Address.
- ☐ Substitute specification.
- ☐ Verified Statement Claiming Small Entity Status.
- ☐ Priority Document.
- ☐ Other:

- ☒ All of the requirements set forth in the notification of MISSING REQUIREMENTS (Form PCT/DO/EO/905) mailed 16 APR 1997 have not been completed.

Applicant is required to complete the response within a time limit of ONE MONTH from the date of this Notification or within the time remaining in the response set forth in the Notification of Missing Requirements (Form DO/EO/905), whichever is the longer. No extension of this time limit may be granted under 37 C.F.R. § 1.136, but the period for response set in the Notification of Missing Requirements may be extended up to a maximum of five months.

Applicant is reminded that any communication to the United States Patent and Trademark Office must be mailed to the address given in the heading and include the U.S. application no. shown above. (37 CFR 1.5)

Enclosed: ☒ PCT/DO/EO/917 ☐ Notice of Defective Translation

*Antal J. Krenn*  
Telephone: (703) 305-3461



UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office  
Address: ASSISTANT COMMISSIONER FOR PATENTS  
Washington, D.C. 20530

08/193,166

|                      |                       |                  |
|----------------------|-----------------------|------------------|
| U.S. APPLICATION NO. | FIRST NAMED APPLICANT | ATTY. DOCKET NO. |
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| INTERNATIONAL APPLICATION NO. |
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|                  |               |
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| I.A. FILING DATE | PRIORITY DATE |
|------------------|---------------|

DATE MAILED:



### NOTIFICATION OF A DEFECTIVE OATH OR DECLARATION

This application fails to contain an oath or declaration acceptable under 35 U.S.C. 371 (c)(4) for entry into the national stage in the United States of America. The period within which to correct these requirements and avoid abandonment is set in the accompanying Office action.

A new oath or declaration, identifying this application by the international application number and international filing date is required. The oath or declaration does not comply with 37 CFR 1.497(a) and (b) in that it:

1. ☒ is not executed in accordance with either 37 CFR 1.66 or 37 CFR 1.68. *by all inventors*
2. ☐ does not identify the specification to which it is directed.
3. ☐ does not identify the inventor(s).
4. ☐ does not identify the citizenship of each inventor.
5. ☐ does not state the person making the oath or declaration believes the named inventor or inventors to be the original and first inventor or inventors of the subject matter which is claimed and for which a patent is sought.

FAILURE TO SUBMIT AN OATH OR DECLARATION IN COMPLIANCE WITH 37 CFR 1.497(a) AND (b) WITHIN THE TIME PERIOD SET WILL RESULT IN FAILURE TO ENTER THE NATIONAL STAGE AND THE ABANDONMENT OF THE APPLICATION.

Additionally, the oath or declaration does not comply with 37 CFR 1.63 in that it:

1. ☐ does not identify the city and state or city and foreign country of residence or each inventor.
2. ☐ does not state that the person making the oath or declaration:
  - a. ☐ has reviewed and understands the contents of the specification, including the claims, as amended by any amendment specifically referred to in the oath or declaration.
  - b. ☐ acknowledges the duty to disclose information which is material to patentability as defined in 37 CFR 1.56.
3. ☐ does not identify the foreign application for patent or inventor's certificate on which priority is claimed pursuant to 37 CFR 1.55, and any foreign application having a filing date before that of the application on which priority is claimed, by specifying the application serial number, country, day, month, and year of its filing.
4. ☐ does not state that the person making the oath or declaration acknowledges the duty to disclose information which is material to patentability as defined in 37 CFR 1.56 which became available between the filing date of the prior application and filing date of the continuation in part application which discloses and claims subject matter in addition to that disclosed in the prior application (37 CFR 1.63(d)).

*[Signature]*  
Telephone: (703) 305-3661



Please type a plus sign (+) inside



Under the Paperwork Reduction Act

persons are required to respond to a collection of information

Patent and Trademark

PTO/SB/01 (8-96)  
1 for use through 9/30/98. OMB 0651-0032  
Office: U.S. DEPARTMENT OF COMMERCE  
It contains a valid OMB control number.



## DECLARATION FOR UTILITY OR DESIGN PATENT APPLICATION

☐ Declaration Submitted  
with Initial Filing

☒ Declaration Submitted after  
Initial Filing

Attorney Docket Number

BOET 0103 PUSA

First Named Inventor

Uwe Witt

### COMPLETE IF KNOWN

Application Number

08/793,966

Filing Date

10 March 1997

Group Art Unit

Examiner Name

Anita Johnson

As a below named inventor, I hereby declare that:

My residence, post office address, and citizenship are as stated below next to my name.

I believe I am the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if plural names are listed below) of the subject matter which is claimed and for which a patent is sought on the invention entitled:

BIOLOGICALLY DEGRADABLE POLYESTER AND  
WORKING MATERIAL CONSISTING THEREOF

(Title of the invention)

the specification of which

☐ is attached hereto  
OR

☒ was filed on (MM/DD/YYYY)

July 12, 1995

as United States Application Number or PCT International

Application Number

PCT/EP95/02722

and was amended on (MM/DD/YYYY)

(if applicable).

I hereby state that I have reviewed and understand the contents of the above identified specification, including the claims, as amended by any amendment specifically referred to above.

I acknowledge the duty to disclose information which is material to patentability as defined in Title 37 Code of Federal Regulations, § 1.56.

I hereby claim foreign priority benefits under Title 35, United States Code § 119 (a)-(d) or § 365(b) of any foreign application(s) for patent or inventor's certificate, or § 365 (a) of any PCT international application which designated at least one country other than the United States of America, listed below and have also identified below, by checking the box, any foreign application for patent or inventor's certificate, or of any PCT international application having a filing date before that of the application on which priority is claimed.

| Prior Foreign Application<br>Number(s) | Country | Foreign Filing Date<br>(MM/DD/YYYY) | Priority<br>Not Claimed  | Certified Copy Attached? |                          |
|--|---------|-------------------------------------|--------------------------|--------------------------|--------------------------|
|  |         |                                     |                          | YES                      | NO                       |
| 44 32 161.9                            | Germany | 09/09/94                            | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> |
| (1) 95 08 737.2                        | Germany | 03/10/95                            | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> |
|  |         |                                     | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> |
|  |         |                                     | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> |
|  |         |                                     | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> |
|  |         |                                     | <input type="checkbox"/> | <input type="checkbox"/> | <input type="checkbox"/> |

☐ Additional foreign application numbers are listed on a supplemental priority sheet attached hereto:

I hereby claim the benefit under Title 35, United States Code § 119(e) of any United States provisional application(s) listed below.

| Application Number(s) | Filing Date (MM/DD/YYYY) | <input type="checkbox"/> Additional provisional application<br>numbers are listed on a<br>supplemental priority sheet<br>attached hereto. |
|-----------------------|--------------------------|---|
|                       |                          |   |

(Page 1 of 5)

Burden Hour Statement: This form is estimated to take 0.4 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner of Patents and Trademarks, Washington, DC 20231

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PTO/SB-01 (8-96)  
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## DECLARATION

I hereby claim the benefit under Title 35, United States Code §120 of any United States application(s), or §365(e) of any PCT international application designating the United States of America, listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States or PCT International application in the manner provided by the first paragraph of Title 35, United States Code §112, I acknowledge the duty to disclose information which is material to patentability as defined in Title 37, Code of Federal Regulations §1.56 which became available between the filing date of the prior application and the national or PCT international filing date of this application.

| U.S. Parent Application Number | PCT Parent Number | Parent Filing Date (MM/DD/YYYY) | Parent Patent Number (if applicable) |
|--------------------------------|-------------------|---------------------------------|--------------------------------------|
|                                | PCT/EP95/02722    | 07/12/95                        |                                      |

☐ Additional U.S. or PCT international application numbers are listed on a supplemental priority sheet attached hereto.

As a named inventor, I hereby appoint the following registered practitioner(s) to prosecute this application and to transact all business in the Patent and Trademark Office connected therewith:

| Name              | Registration Number | Name | Registration Number |
|-------------------|---------------------|------|---------------------|
| William C. Conger | 31,209              |      |                     |

☒ Additional registered practitioner(s) named on a supplemental sheet attached hereto.

Direct all correspondence to:

|         |                                       |           |                |
|---------|---------------------------------------|-----------|----------------|
| Name    | Mr. William G. Conger                 |           |                |
| Address | Brooks & Kushman P.C.                 |           |                |
| Address | 1000 Town Center, Twenty-Second Floor |           |                |
| City    | Southfield                            | State     | Michigan       |
| Country | US                                    | Telephone | (810) 358-4400 |
|         |                                       | Fax       | (810) 358-3351 |

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Name of Sole or First Inventor: ☐ A petition has been filed for this unsigned inventor

|                      |     |                |  |             |      |                 |  |
|----------------------|-----|----------------|--|-------------|------|-----------------|--|
| Given Name           | Uwe | Middle Initial |  | Family Name | Witt | Suffix e.g. Jr. |  |
| Inventor's Signature |     |                |  |             |      | Date            |  |

|                     |                                       |       |  |         |                             |             |                             |
|---------------------|---------------------------------------|-------|--|---------|-----------------------------|-------------|-----------------------------|
| Residence: City     | Braunschweig                          | State |  | Country | Federal Republic of Germany | Citizenship | German                      |
| Post Office Address | Mascheroder Weg 1, 38124 Braunschweig |       |  |         |                             |             |                             |
| Post Office Address |                                       |       |  |         |                             |             |                             |
| City                | Braunschweig                          | State |  | Zip     |                             | Country     | Federal Republic of Germany |

☒ Additional inventors are being named on supplemental sheet(s) attached hereto



8519

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Approved for use through 12/31/98. OMB 0351-0032

Patent and Trademark Office U.S. DEPARTMENT OF COMMERCE

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## DECLARATION

ADDITIONAL INVENTOR(S)  
Supplemental Sheet

|  |                                       |   |                             |
|--|---------------------------------------|---|-----------------------------|
| Name of Additional Joint Inventor, if any: |                                       | <input type="checkbox"/> A petition has been filed for this unsigned inventor |                             |
| Given Name                                 | Rolf-Joachim                          | Middle Initial  | Family Name                 |
|  |                                       |   | Mueller                     |
| Inventor's Signature                       | Rolf-Joachim Mueller                  |   | Date                        |
|  |                                       |   | 09. Mai 1997                |
| Residence: City                            | Braunschweig                          | State   | Country                     |
|  |                                       |   | Federal Republic of Germany |
| Post Office Address                        | Mascheroder Weg 1, 38124 Braunschweig |   |                             |
| Post Office Address                        |                                       |   |                             |
| City                                       | Braunschweig                          | State   | Country                     |
|  |                                       |   | Federal Republic of Germany |
| Name of Additional Joint Inventor, if any: |                                       | <input type="checkbox"/> A petition has been filed for this unsigned inventor |                             |
| Given Name                                 | Wolf-Dieter                           | Middle Initial  | Family Name                 |
|  |                                       |   | Deckwer                     |
| Inventor's Signature                       | Wolf-Dieter Deckwer                   |   | Date                        |
|  |                                       |   | 09. Mai 1997                |
| Residence: City                            | Braunschweig                          | State   | Country                     |
|  |                                       |   | Federal Republic of Germany |
| Post Office Address                        | Mascheroder Weg 1, 38124 Braunschweig |   |                             |
| Post Office Address                        |                                       |   |                             |
| City                                       | Braunschweig                          | State   | Country                     |
|  |                                       |   | Federal Republic of Germany |
| Name of Additional Joint Inventor, if any: |                                       | <input type="checkbox"/> A petition has been filed for this unsigned inventor |                             |
| Given Name                                 |                                       | Middle Initial  | Family Name                 |
|  |                                       |   |                             |
| Inventor's Signature                       |                                       |   | Date                        |
|  |                                       |   |                             |
| Residence: City                            |                                       | State   | Country                     |
|  |                                       |   |                             |
| Post Office Address                        |                                       |   |                             |
| Post Office Address                        |                                       |   |                             |
| City                                       |                                       | State   | Country                     |
|  |                                       |   |                             |
| Name of Additional Joint Inventor, if any: |                                       | <input type="checkbox"/> A petition has been filed for this unsigned inventor |                             |
| Given Name                                 |                                       | Middle Initial  | Family Name                 |
|  |                                       |   |                             |
| Inventor's Signature                       |                                       |   | Date                        |
|  |                                       |   |                             |
| Residence: City                            |                                       | State   | Country                     |
|  |                                       |   |                             |
| Post Office Address                        |                                       |   |                             |
| Post Office Address                        |                                       |   |                             |
| City                                       |                                       | State   | Country                     |
|  |                                       |   |                             |

☐ Additional inventors are being named on supplemental sheet(s) attached hereto

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## DECLARATION

## REGISTERED PRACTITIONER INFORMATION (Supplemental Sheet)

| Name                 | Registration<br>Number | Name                   | Registration<br>Number |
|----------------------|------------------------|------------------------|------------------------|
| Ernie L. Brooks      | 26,260                 | Robert C. Brandenburg  | 29,048                 |
| James A. Kushman     | 25,634                 | Paul M. Schwartz       | 33,278                 |
| David R. Syrowik     | 27,956                 | James R. Ignatowski    | 26,741                 |
| Mark A. Cantor       | 30,614                 | A. Frank Duke          | 20,937                 |
| Ralph M. Burton      | 17,748                 | Timothy G. Newman      | 34,228                 |
| John A. Artz         | 25,824                 | John M. Halan          | 35,534                 |
| Robert C.J. Tuttle   | 27,962                 | Jeffrey M. Szuma       | 35,700                 |
| Earl J. LaFontaine   | 30,766                 | Frank A. Angileri      | 36,733                 |
| Ronald M. Nabozny    | 28,648                 | William G. Conger      | 31,209                 |
| Thomas A. Lewry      | 30,770                 | Robert C. Jones        | 35,209                 |
| John E. Nemazi       | 30,876                 | Rhonda L. McCoy-Pfau   | 37,887                 |
| Kevin J. Heintz      | 29,805                 | Christopher W. Quinn   | 38,274                 |
| William G. Abbatt    | 31,936                 | David S. Bir           | 38,383                 |
| Donald J. Harrington | 17,427                 | Sangeeta G. Shah       | 38,614                 |
| Frederick M. Ritchie | 18,669                 | Konstantine J. Diamond | 39,657                 |
| Keith L. Zerschling  | 18,496                 | John S. Artz           | 36,431                 |
| Hugo Delevie         | 32,688                 |                        |                        |

As a below named inventor, I hereby declare that:

My residence, post office address and citizenship are as stated below next to my name.

I believe I am the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if plural names are listed below) of the subject matter which is claimed and for which a patent is sought on the invention entitled

**Biologically degradable polyester and working material consisting**

the specification of which **thereof**

(check one) ☐ is attached hereto.

☐ was filed on \_\_\_\_\_ as

Application Serial No. \_\_\_\_\_

and was amended on \_\_\_\_\_

(if applicable)

I hereby state that I have reviewed and understand the contents of the above identified specification, including the claims, as amended by any amendment referred to above.

I acknowledge the duty to disclose information which is material to the examination of this application in accordance with Title 37, Code of Federal Regulations, §1.56(a).

I hereby claim foreign priority benefits under Title 35, United States Code, §119 of any foreign application(s) for patent or inventor's certificate listed below and have also identified below any foreign application for patent or inventor's certificate having a filing date before that of the application on which priority is claimed:

Prior Foreign Application(s)

| COUNTRY | APPLICATION NUMBER | DATE OF FILING<br>(day, month, year) | PRIORITY CLAIMED  |
|---------|--------------------|--------------------------------------|---|
| Germany | 44 32 161.9        | 09 09 1994                           | <input checked="" type="checkbox"/> YES <input type="checkbox"/> NO |
| Germany | (1)95 08 737.2     | 10 03 1995                           | <input type="checkbox"/> YES <input type="checkbox"/> NO            |
|         |                    |                                      | <input type="checkbox"/> YES <input type="checkbox"/> NO            |

I hereby claim the benefit under Title 35, United States Code §120 of any United States application(s) listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States application in the manner provided by the first paragraph of Title 35, United States Code, §112, I acknowledge the duty to disclose material information as defined in Title 37, Code of Federal Regulations, §1.56(a) which occurred between the filing date of the prior application and the national or PCT international filing date of this application:

| APPLICATION NUMBER | DATE OF FILING<br>(day, month, year) | STATUS<br>(patented, pending, abandoned) |
|--------------------|--------------------------------------|--|
|                    |                                      |  |
|                    |                                      |  |

POWER OF ATTORNEY: As a named inventor, I hereby appoint the following attorney(s) to prosecute this application and transact all business in the Patent and Trademark Office connected therewith. Joseph C. Sullivan, Registration No. 18,720; John Kurucz, Registration No. 18,888; Gerald Levy, Registration No. 24,419; Joseph T. Eisele, Registration No. 25,331; Ronald R. Santucci, Registration No. 28,988; William H. Dippert, Registration No. 28,723; Tiberiu Weiss, Registration No. 29,878; Ronald E. Brown, Registration No. 32,200 and John Gulbin, Registration No. 33,180-I (WE) further authorize my (our) attorney to insert the proper serial number and filing date awarded to my (our) application on this form, above my (our) signature(s).

|   |                         |   |                                  |                           |
|---|-------------------------|---|----------------------------------|---------------------------|
| SEND CORRESPONDENCE TO:   |                         | DIRECT TELEPHONE CALLS TO:<br>(name and telephone number) |                                  |                           |
| KANE, DALSIMER, SULLIVAN, KURUCZ,<br>LEVY, EISELE and RICHARD<br>711 Third Avenue<br>New York, New York 10017-4088  |                         | 212 687-8000  |                                  |                           |
| 201   | FULL NAME OF INVENTOR   | FAMILY NAME<br>Witt                                       | FIRST GIVEN NAME<br>Uwe          | SECOND GIVEN NAME         |
|   | RESIDENCE & CITIZENSHIP | CITY<br>Braunschweig                                      | STATE OR FOREIGN COUNTRY<br>FRG  | COUNTRY OF CITIZENSHIP    |
|   | POST OFFICE ADDRESS     | Mascheroder Weg 1, 38124 Braunschweig                     |                                  |                           |
| 202   | FULL NAME OF INVENTOR   | FAMILY NAME<br>Mueller                                    | FIRST GIVEN NAME<br>Rolf-Joachim | SECOND GIVEN NAME         |
|   | RESIDENCE & CITIZENSHIP | CITY<br>Braunschweig                                      | STATE OR FOREIGN COUNTRY         | COUNTRY OF CITIZENSHIP    |
|   | POST OFFICE ADDRESS     | Mascheroder Weg 1, 38124 Braunschweig                     |                                  |                           |
| 203   | FULL NAME OF INVENTOR   | FAMILY NAME<br>Deckwer                                    | FIRST GIVEN NAME<br>Wolf-Dieter  | SECOND GIVEN NAME         |
|   | RESIDENCE & CITIZENSHIP | CITY<br>Braunschweig                                      | STATE OR FOREIGN COUNTRY         | COUNTRY OF CITIZENSHIP    |
|   | POST OFFICE ADDRESS     | Mascheroder Weg 1, 38124 Braunschweig                     |                                  |                           |
| I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon. |                         |   |                                  |                           |
| SIGNATURE OF INVENTOR 201   |                         | SIGNATURE OF INVENTOR 202                                 |                                  | SIGNATURE OF INVENTOR 203 |
| Uwe Witt  |                         | Rolf-Joachim Mueller                                      |                                  | Wolf-Dieter Deckwer       |
| DATE 08.08.1995   |                         | DATE 08.08.1995   |                                  | DATE 08.08.1995           |



03 FEB 2000



UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office

Patent Cooperation Treaty  
Legal Office

Address: Assistant Commissioner for Patents  
Box PCT  
Washington, D.C. 20231



William G. Conger  
1000 Town Center  
Twenty-Second Floor  
Southfield, MI 48075

In re Application of  
Uwe Witt et al.  
Serial No. 08/793966  
PCT No.: PCT/EP95/02722  
Int. Filing Date: 12 July 1995  
Priority Date: 09 September 1994  
Attorney's Docket No.: BOET 0103 PUSA  
For: Biologically Degradable Polyester and Working  
Material Consisting Thereof

DECISION

ON

PETITION

Dec. 4-3-00  
2llk

This is in response to the "Combined Petition for Revival of an Application for Patent Abandoned Unavoidably Under 37 C.F.R. 1.137(a) and Showing Related Thereto Under 37 C.F.R. 1.137(a)(3)" of 05 April 1999.

**BACKGROUND**

On 27 June 1996, applicant filed international application No. PCT/EP95/02722 which claimed an earliest priority date of 09 September 1994 and which designated the United States.

On 04 April 1996, a Demand was filed with the International Preliminary Examining Authority electing the United States. The election was made prior to the expiration of 19 months from the priority date. As a result, the deadline for submission of a copy of the international application (unless previously communicated by the International Bureau) and payment of the basic national fee was extended to expire 30 months from the priority date, on 10 March 1997 (since 09 March 1997 was a Sunday).

On 10 March 1997, applicant filed a transmittal letter for entry into the national stage in the United States. The transmittal letter was accompanied by, *inter alia*, the basic national fee.

On 16 April 1997, a Notification of Missing Requirements Under 35 U.S.C. 371 in the United States Designated/Elected Office (DO/EO/US) (Form PCT/DO/EO/905) and a Notification of a Defective Oath or Declaration (Form PCT/DO/EO/917) were mailed to applicant, requiring the submission of an oath or declaration in compliance with 37 CFR



1.497(a) and (b) and a surcharge under 37 CFR 1.492(e) by 19 May 1997 (since 17 May 1997 was a Saturday). The declaration was deemed defective in that it did not identify the citizenship of each inventor, and did not identify the city and state or city and foreign country of residence of each inventor.

On 15 May 1997, applicant submitted a "Declaration for Utility or Design Patent Application" which identified the name, city and country of residence, citizenship, and post office address of each of the inventors, but which was not signed by inventor Uwe Witt.

On 25 June 1997, a Notification of a Defective Response (Form PCT/DO/EO/916) and a Notification of a Defective Oath or Declaration (Form PCT/DO/EO/917) were mailed to applicant, indicating that all of the requirements set forth in the PCT/DO/EO/905 mailed on 16 April 1997 had not been met in that the declaration of 15 May 1997 had not been executed by all of the inventors in accordance with 37 CFR 1.66 or 1.68. The PCT/DO/EO/916 set a one month time limit to complete the response to the PCT/DO/EO/905 mailed on 16 April 1997.

On 08 July 1997, applicant submitted an "Applicants' Response to 'Notification of a Defective Response'", which indicated that the declarations of 15 May 1997 and 10 March 1997, taken together, fully satisfied the requirements of 37 CFR 1.497 and 1.63 and requested acknowledgment of such satisfaction.

On 02 January 1998, a Notification of Abandonment (Form PCT/DO/EO/909) was mailed to applicant, indicating that this application had been abandoned as to the United States because "Applicant has failed to properly respond to the defective response notice. 1st Declaration citizenship was omitted 2nd Declaration one applicant did not sign."

On 17 September 1998, applicant submitted a Status Letter.

On 17 November 1998, a communication was mailed to applicant in response to the status letter of 17 September 1998, indicating that the application had become abandoned as reflected by the Form PCT/DO/EO/909 mailed on 02 January 1998. A copy of said Form PCT/DO/EO/909 accompanied the communication.

On 05 April 1999, applicant submitted the instant petition.

### **DISCUSSION**

A grantable petition to revive an abandoned application under 37 CFR 1.137(a) must be accompanied by (1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof; (2) the petition fee as set forth in § 1.17(l); (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due

date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable; and (4) any terminal disclaimer (and fee as set forth in § 1.20 (d)) required pursuant to paragraph (c) of this section. This petition does not satisfy requirement (3).

Petitioner has failed to provide a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable. Petitioner did not submit a proper oath or declaration until the filing of the declaration accompanying the instant petition, on 05 April 1999. The declarations submitted on 10 March 1997 and 15 May 1997 do not constitute the required reply to the Notification of Missing Requirements Under 35 U.S.C. 371 in the United States Designated/Elected Office (DO/EO/US) (Form PCT/DO/EO/905) and a Notification of a Defective Oath or Declaration (Form PCT/DO/EO/917) of 16 April 1997 because Uwe Witt did not attest to his country of citizenship in either declaration. Petitioner argues that the declarations, taken together, "give all the required data" and that therefore no further declaration is required under the practice of MPEP 602.02. Unfortunately, the declarations of 10 March 1997 and 15 May 1997 do not "give all the required data" in that inventor Uwe Witt did not execute all of the required data. As such, the two declarations, even taken together, are incomplete and so do not constitute the required reply. Therefore, the required reply was not submitted until the filing of the declaration accompanying the petition of 05 April 1999.

Petitioner argues that the portion of the delay in filing the required reply extending from the filing of the defective declaration of 15 May 1997 to the filing of a grantable petition was unavoidable because "Applicants could not be aware that their response was insufficient without being notified of any alleged insufficiency" and that "Because Applicants never received any notification that this time period was running, and because Applicants never received any indication that the case was abandoned, Applicants submit that the abandonment was unavoidable." However, petitioner was notified that the declaration of 10 March 1997 was defective by the Notification of Missing Requirements Under 35 U.S.C. 371 in the United States Designated/Elected Office (DO/EO/US) (Form PCT/DO/EO/905) and a Notification of a Defective Oath or Declaration (Form PCT/DO/EO/917) mailed on 16 April 1997. Petitioner was notified that the declaration of 15 May 1997 was defective by the Notification of a Defective Response (Form PCT/DO/EO/916) and a Notification of a Defective Oath or Declaration (Form PCT/DO/EO/917) of 25 June 1997. Therefore, petitioner was notified that both declarations were insufficient. Given such notice, petitioner was required to exercise appropriate diligence in submitting the required reply in a timely manner. Petitioner has not shown why, despite such notification, the delay in submitting a proper oath or declaration was unavoidable within the meaning of 37 CFR 1.137(a).

Petitioner argues that the Notification of Abandonment mailed on 02 January 1998 was not received, failed to properly identify the subject application and applicant, and was mailed to an incorrect address. Review of the record reveals that the Notification of Abandonment in fact did contain erroneous information, and was in fact not mailed to

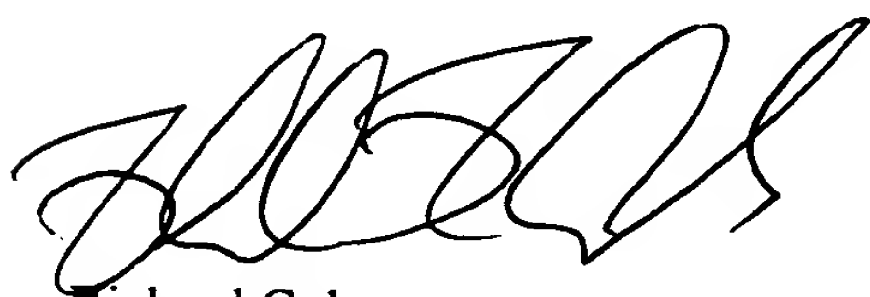
applicants' correspondence address of record. Notwithstanding these facts, any improper mailing of the Notification of Abandonment does not operate to excuse petitioner from the requirement to exercise due diligence in responding to the Notification of Missing Requirements Under 35 U.S.C. 371 in the United States Designated/Elected Office (DO/EO/US) (Form PCT/DO/EO/905) and a Notification of a Defective Oath or Declaration (Form PCT/DO/EO/917) mailed on 16 April 1997 and the Notification of a Defective Response (Form PCT/DO/EO/916) and a Notification of a Defective Oath or Declaration (Form PCT/DO/EO/917) of 25 June 1997. As such, petitioner's arguments concerning the Notification of Abandonment are not sufficient to establish unavoidable delay within the meaning of 37 CFR 1.137(a).

**DECISION**

For the above reasons, Applicant's Request in the above-captioned application is **DISMISSED** without prejudice.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mailing date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. Any such request for reconsideration should include a cover letter entitled "Renewed Petition Under 37 CFR 1.137(a)." Applicant may also wish to consider filing a petition under 37 CFR 1.137(b).

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, DC 20231, with the contents of the letter marked to the attention of the PCT Legal Office.



Richard Cole  
PCT Legal Examiner  
PCT Legal Office



George M. Dombroske  
PCT Legal Examiner  
PCT Legal Office  
Tel: (703) 308-6721  
Fax: (703) 308-6459

*Intellectual Property and Technology Related Cases*

Ernie L. Brooks  
James A. Kushman  
David R. Syrowik  
Mark A. Cantor  
Ralph M. Burton  
Robert C. J. Tuttle  
Earl J. LaFontaine  
Ronald M. Nabozny  
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Timothy G. Newman  
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Jeffrey M. Szuma  
Maria Franek Angileri

Frank A. Angileri  
William G. Conger  
Christopher W. Quinn  
Sangeeta G. Shah  
George R. Mosher  
Frederick M. Ritchie  
John M. Sheridan  
Elizabeth F. Janda  
Robert C. Brandenburg

A. Frank Duke  
James R. Ignatowski  
Konstantine J. Diamond  
David S. Bir  
James N. Kallis  
Hugo A. Delevie  
Ralph E. Smith  
Gigette M. Bejin  
Mark E. Stuenkel

Michael S. Brodbine  
Seth E. Rodack  
Pete N. Kioussis  
Raymond J. Vivacqua  
John J. Ignatowski  
James W. Proscia  
Ginta D. Kukainis  
Lawrence G. Almeda

Registered  
Patent Agents

Mark D. Chuey, Ph.D.  
Stephanie M. Mansfield, Ph.D.  
Jeremy J. Curcuri  
Robert C. Jones  
Matthew R. Mowers

March 2, 2000

Dr. Hans D. Boeters  
BOETERS & BAUER  
Bereiteranger 15  
D-81541 München  
GERMANY

VIA FACSIMILE  
ORIGINAL BY MAIL

**Re: National Phase In The United States**  
**Corresponding to Patent Cooperation Treaty**  
**Serial No. PCT/EP95/02722**  
**Filed: 12 July 1995**  
**Title: BIOLOGICALLY DEGRADABLE POLYESTER AND**  
**WORKING MATERIAL CONSISTING THEREOF**  
**Your Ref.: 8519**  
**Our File: BOET 0103 PUSA**

Dear Dr. Boeters:

The two Declarations filed with this case, each lacking certain data regarding either or both of country of residence or citizenship, were held by the PCT Legal Office of the U.S.P.T.O. to be legally insufficient in their "Notification of Defective Response" dated June 30, 1997. In response, we argued that while each Declaration, standing alone, might be insufficient, the two Declarations together supplied all the necessary data. We also, at the same time, requested acknowledgment that the two Declarations were sufficient. However, we heard nothing from the Office until we submitted a Status Request on September 14, 1998. Following this Status Request, we were informed that a Notice of Abandonment was mailed on January 2, 1998. We obtained a fax copy from the Patent Office, and determined that it had been mailed to someone in Greece.

We disagree with the conclusion of the PCT legal branch that the two Declarations together are not sufficient, and also object to the procedure followed by the Patent Office. Accordingly, we filed a Petition for Revival of the application based on "unavoidable abandonment", since we were never notified, as requested in our response of July 8, 1997, that the Office disagreed with our conclusion that the two Declarations together were legally sufficient.



Dr. Hans D. Boeters  
February 29, 2000  
Page 2

We have now received an adverse decision on our petition. While we still believe that the Office is in error, we must now decide what further action to take. If the client still wishes to pursue the patent, then we could 1) request reconsideration of the Decision on the petition, or 2) convert the Petition to one of unintentional abandonment, which requires a fee of \$650.00

Based on my experience, I do not believe the Office will reverse their decision on the petition. Therefore, if the client wishes to retain the application, I would recommend converting the petition to one for unintentional abandonment, paying the extra fee.

The chain of events is very unfortunate, but was caused by the inadequacy of the two initial Declarations. As you may recall, one inventor was unavailable to the client at the time the second Declaration was required. Apparently, he has since been located, as we did receive, pursuant to our request of November 24, 1998, a Declaration which meet all the requirements and was executed by all inventors. This Declaration was filed with our Petition, and does not require refiling.

Please inform us as soon as possible of what course of action to take. We have until **April 3, 2000** to take action without incurring fees for extension of time.

Very truly yours,

**BROOKS & KUSHMAN P.C.**



William G. Conger

WGC/slk  
Enclosures



BROOKS & KUSHMAN P.C.

Intellectual Property and Technology Related Causes

Eric L. Brooks  
James A. Kuchman  
David R. O'Connell  
Mark A. Gorman  
Robert M. Burton  
Robert C. J. Ellis  
Earl J. Laskowski  
Ronald M. Nadeau  
Thomas A. Leary

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Robert C. Jones  
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March 2, 2000


Dr. Hans D. Boeters  
BOETERS & BAUER  
Berlinerstrasse 15  
D-81541 Muenich  
GERMANY

VIA FACSIMILE  
ORIGINAL BY MAIL

July 28, 2000

Dear Mr. Conger:

We regret to say that we have never received your March 2, 2000 letter. Please file a petition of unintentional abandonment and pay the extension fees. Thank you very much for your assistance. Kind regards,

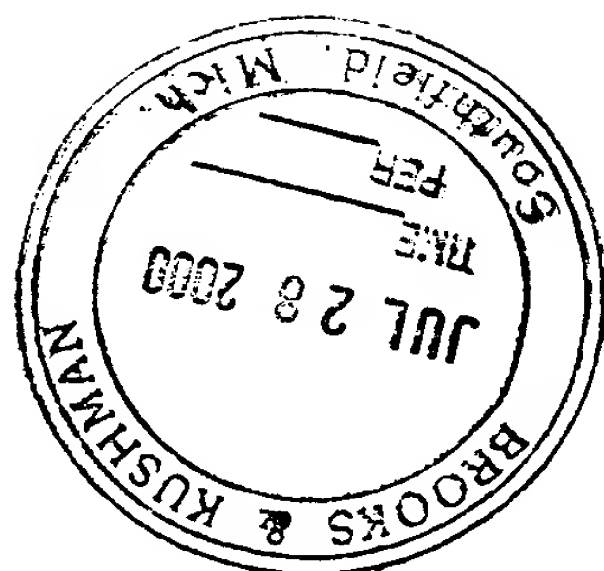
  
BOETERS & BAUER

Re: National Phase In The United States  
Corresponding to Patent Cooperation Treaty  
Serial No. PCT/EP95/02722  
Filed: 12 July 1995  
Title: BIOLOGICALLY DEGRADABLE POLYESTER AND  
WORKING MATERIAL CONSISTING THEREOF  
Your Ref.: 8519 /S 793 966  
Our File: BOET 9103 PUSA

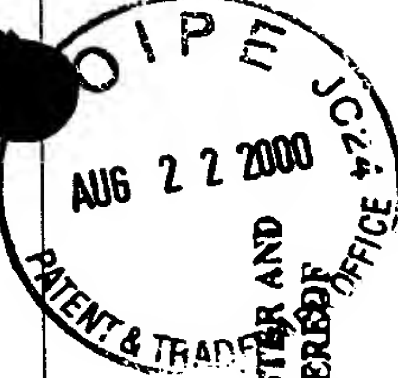
Dear Dr. Boeters:

The two Declarations filed with this case, each lacking certain data regarding either or both of country of residence or citizenship, were held by the PCT Legal Office of the U.S.P.T.O. to be legally insufficient in their "Notification of Defective Response" dated June 30, 1997. In response, we argued that while each Declaration, standing alone, might be insufficient, the two Declarations together supplied all the necessary data. We also, at the same time, requested acknowledgment that the two Declarations were sufficient. However, we heard nothing from the Office until we submitted a Status Request on September 14, 1998. Following this Status Request, we were informed that a Notice of Abandonment was mailed on January 2, 1998. We obtained a fax copy from the Patent Office, and determined that it had been mailed to someone in Greece.

We disagree with the conclusion of the PCT legal branch that the two Declarations together are not sufficient, and also object to the procedure followed by the Patent Office. Accordingly, we filed a Petition for Revival of the application based on "unavoidable abandonment", since we were never notified, as requested in our response of July 8, 1997, that the Office disagreed with our conclusion that the two Declarations together were legally sufficient.



1000 TOWN CENTER, TWENTY-SECOND FLOOR, SOUTHFIELD, MICHIGAN 48076  
TELEPHONE (248) 358-4000, FACSIMILE (248) 358-3351





DECLARATION FOR PATENT APPLICATION AND POWER OF ATTORNEY



Atty. Docket No. BOET 0103 PUSA  
First Named Inventor Uwe Witt et al.

As a below named inventor, I hereby declare that my residence, post office address and citizenship are as stated below next to my name.

I believe I am the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if plural names are listed below) of the subject matter which is claimed and for which a patent is sought on the invention entitled:

**BIOLOGICALLY DEGRADABLE POLYESTER AND WORKING MATERIAL CONSISTING THEREOF**

the specification of which:

- ☐ is attached hereto; or  
☒ was filed on (MM/DD/YYYY) March 10, 1997 as U.S. Application Number or PCT International Application Number PCT/EP95/02722, and was amended on (MM/DD/YYYY) \_\_\_\_\_ (if applicable).

I hereby state that I have reviewed and understand the contents of the above-identified specification, including the claims, as amended by any amendment specifically referred to above.

I acknowledge the duty to disclose information which is material to the examination of this application in accordance with Title 37, Code of Federal Regulations, § 1.56.

I hereby claim foreign priority benefits under Title 35, United States Code, § 119(a)-(d) or § 365(b) of any foreign application(s) for patent or inventor's certificate, or § 365(a) of any PCT international application which designated at least one country other than the United States of America, listed below, and have also identified below, by checking the box, any foreign application for patent or inventor's certificate, or of any PCT international application having a filing date before that of the application on which priority is claimed.

| <i>Prior Foreign Application Number(s)</i> | <i>Country</i> | <i>Foreign Priority Date (MM/DD/YYYY)</i> | <i>Priority Not Claimed</i> | <i>Certified Copy Attached? (Yes/No)</i> |
|--|----------------|---|-----------------------------|--|
| 44 32 161.9                                | Germany        | September 9, 1994                         |                             | No                                       |
| (1) 95 08 737.2                            | Germany        | March 10, 1995                            |                             | No                                       |
|  |                |   |                             |  |

I hereby claim the benefit under Title 35, United States Code, § 119(e) of any United States provisional application(s) listed below.

| <i>Application Number(s)</i> | <i>Filing Date (MM/DD/YYYY)</i> |
|------------------------------|---------------------------------|
|                              |                                 |
|                              |                                 |

I hereby claim the benefit under Title 35, United States Code, § 120 of any United States application(s) listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States application in the manner provided by the first paragraph of Title 35, United States Code § 112, I acknowledge the duty to disclose material information as defined in Title 37, Code of Federal Regulations, § 1.56 which occurred between the filing date of the prior application and the national or PCT international filing date of this application.

| <i>Application Number(s)</i> | <i>Filing Date (MM/DD/YYYY)</i> | <i>Status: Patented, Pending, Abandoned</i> |
|------------------------------|---------------------------------|---|
|                              |                                 |   |
|                              |                                 |   |

**Declaration for Patent Application (cont'd.)**Atty. Docket No. BOET 0103 PUSA

I hereby appoint the following registered practitioners to prosecute this application and to transact all business in the Patent and Trademark Office connected therewith:

Ernie L. Brooks, Reg. No. 26,260; James A. Kushman, Reg. No. 25,634; David R. Syrowik, Reg. No. 27,956; Mark A. Cantor, Reg. No. 30,614; Ralph M. Burton, Reg. No. 17,748; Robert C.J. Tuttle, Reg. No. 27,962; Earl J. LaFontaine, Reg. No. 30,766; Ronald M. Nabozny, Reg. No. 28,648; Thomas A. Lewry, Reg. No. 30,770; John E. Nemazi, Reg. No. 30,876; Kevin J. Heintz, Reg. No. 29,805; William G. Abbatt, Reg. No. 31,936; Donald J. Harrington, Reg. No. 17,427; Paul M. Schwartz, Reg. No. 33,278; Timothy G. Newman, Reg. No. 34,228; Frederick M. Ritchie, Reg. No. 18,669; Robert C. Brandenburg, Reg. No. 29,048; A. Frank Duke, Reg. No. 20,937; John M. Halan, Reg. No. 35,534; Jeffrey M. Szuma, Reg. No. 35,700; James R. Ignatowski, Reg. No. 26,741; Frank A. Angileri, Reg. No. 36,733; William G. Conger, Reg. No. 31,209; Rhonda L. McCoy-Pfau, Reg. No. 37,887; Sangeeta G. Shah, Reg. No. 38,614; Christopher W. Quinn, Reg. No. 38,274; Robert C. Jones, Reg. No. 35,209; David S. Bir, Reg. No. 38,383; Konstantine J. Diamond, Reg. No. 39,657; James N. Kallis, Reg. No. 41,102; Hugo A. Delevie, Reg. No. 32,688; Ralph E. Smith, Reg. No. 35,474; Michael S. Brodbine, Reg. No. 38,392; Jeremy J. Curcuri, Reg. No. 42,454; Mark D. Chuey, Reg. No. 42,415; and John J. Ignatowski, Reg. No. 36,555; Pete N. Kioussis, Reg. No. 41,117; Gigette M. Bejin, Reg. No. P-44,027; Stephanie M. Mansfield, Reg. No. P-43,773; Mark E. Stuenkel, Reg. No. P-44,364.

Address all correspondence and telephone calls to William G. Conger  
at Brooks & Kushman P.C., 1000 Town Center, Twenty-Second Floor, Southfield, Michigan 48075, (248) 358-4400.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

**Full Name of Sole or First Inventor** Uwe Witt

Inventor's signature X [Signature] Date 17/1/99

Post Office Address Same As Residence Address

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**Full Name of Second Joint Inventor** Rolf-Joachim Mueller

Inventor's signature X [Signature] Date 28.01.99

Post Office Address Same As Residence Address

Residence Mascheroder Weg 1, 38124 Braunschweig, Germany Citizenship German

**Full Name of Third Joint Inventor** Wolf-Dieter Deckwer

Inventor's signature X [Signature] Date 14/1.99

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